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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,533	09/12/2003	John P. Panunto	6480-03	5337
23477	7590	01/03/2006	EXAMINER	
MARKS & CLERK 1075 NORTH SERVICE ROAD WEST SUITE 203 OAKVILLE, ON L6M 2G2 CANADA			MORRISON, THOMAS A	
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			3653	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/660,533	Applicant(s) PANUNTO ET AL.	
	Examiner Thomas A. Morrison	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/12/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed box ready sensor of claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both a transport conveyer and what appears to be an axle of the transport conveyer. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: (1) the omitted structure with regard to the storage bin in independent claim 1 needed to understand

how media from the bottom of the storage bin are permitted to pass through the coarse media separator from the bottom of the storage bin in quantities of at least one media element; (2) the omitted structural relationship between the claimed elements (e.g., the rear conveyer and the coarse media separator) in independent claim 1 to understand what allows the media to lie on the rear conveyer in single or shingled arrangement; (3) the omitted structural relationship between the claimed elements (e.g., box ready sensor and the transport conveyer) in claim 9 needed to understand how the transport conveyer is started; and (4) the omitted structural relationship between the claimed elements (e.g., the transport conveyer and the front conveyer) in claim 10 needed to understand how the apparatus starts both operations at the same time.

Regarding claim 9, it is unclear what is meant by the recited "box ready event".

Regarding claim 11, this claim recites that each of the coarse media separator and the single media separator comprises a nip roller which overlies the respective rear or front conveyer, whereby media elements are pulled through the respective separator by the frictional engagement of the bottommost media element in a quantity determined by the vertical spacing of the respective nip roller away from the respective conveyer. This recitation is generally confusion and indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 7-8, as best understood, are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,550,764 (Wilson et al.).

Regarding claim 1, Figs. 3-9j show a dispenser (1) for dispensing flat media seriatim from a discharge end thereof remote from a media storage end of thereof, the dispenser including

a media storage bin (including 5, 7 and 9) at a first end thereof and a discharge chute (near numeral 42) at a second end thereof;

a first coarse media separator (including 53) located adjacent the media storage bin (including 5, 7 and 9) at a first end of a driven rear conveyor (nuder rollers of 17 in column 13, lines 26-27) which is intermittently driven at a first linear velocity  $V_R$  to convey the media towards a second single media separator (including 54);

a driven front conveyor (31) associated with the single media separator (including 54), the front conveyor (31) being intermittently driven at a second linear velocity  $V_F$ ;

a transport conveyor (50) located after the front conveyor (31), between the front conveyor (31) and the discharge chute (near numeral 42), the transport conveyor (50) being intermittently driven at a third linear velocity  $V_T$ ;

a first sensor (241) for sensing the presence or absence of media at the discharge end of the transport conveyor (50);

a second sensor (231) for sensing the presence or absence of media on the transport conveyor (50); and

a third sensor (213) for sensing the presence or absence of media at a location between the front conveyor (31) and the rear conveyor (nudger rollers of 17 in column 13, lines 26-27); wherein media from the bottom of the storage bin (i.e., media on bottom portion 7) are permitted to pass through the coarse media separator (including 53) from the bottom of the storage bin (i.e., from bottom portion 7) in quantities of at least one media element, and are permitted to lie on the rear conveyor (nudger rollers of 17 in column 13, lines 26-27) in shingled arrangement (see, e.g., Fig. 3) in which the leading edge of a media element overlies the trailing edge of the next adjacent media element which is closer to the single media separator (including 54); wherein media on the rear conveyor (nudger rollers of 17 in column 13, lines 26-27) are pulled into the single media separator (including 54) one at a time by the front conveyor (31), and they are delivered by the front conveyor (31) to the transport conveyor (50) seriatim; and wherein the rear conveyor (nudger rollers of 17 in column 13, lines 26-27) operates only when the third sensor (213) senses the absence of media thereat. See, e.g., column 14, lines 17-20 and Fig. 8g.

Regarding claim 2, column 13, lines 26-30 explain the speed of the nudger rollers of 17 (i.e.,  $V_R = 37.4\text{ips}$ ). Also, column 5, lines 52-55 and column 13, lines 60-62 explain the speed of the belt 42 that drives media at a speed ( $V_F = 42\text{ ips}$ ) through front conveyor (31). As such,  $V_F > V_R$ . Also, Figs. 9f-9g show a situation where  $V_T > V_F$ . In

other words, Figs. 9f-9g show the speed of media at the front conveyer (31) can be slower than the speed of media at the transport conveyer (50).

Regarding claim 3, Fig.3 shows that at least portion 9 of the media storage bin is arranged vertically. As such, the media bin can be considered to be arranged vertically, as claimed.

Regarding claim 7, Fig. 3 shows that each of the coarse media separator (including 53) and the single media separator (including 54) is vertically adjustable (e.g., via springs 111 and 115) so as to accommodate the thickness of the individual media elements to be dispensed during an operating cycle of the dispenser.

Regarding claim 8, Figs. 8h and 8j show that the first sensor (241) operates to stop operation of the transport conveyer (50) when it senses the presence of media thereat.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,550,764 (Wilson et al.).

Regarding claims 4 and 12, Fig. 3 shows that front conveyer comprises at least two parallel conveyer belts (33 and 35), but does not show that the rear conveyer



(nudger rollers of 17) has two belts. In fact, the Wilson et al. patent meets the limitations of the claim except that it employs what appears to be a single belt on the rear conveyer rather than two parallel belts in order to convey sheets out of a storage bin. However, these two elements were art recognized equivalents at the time of the invention in those sheet conveying applications where it is immaterial whether a plurality of narrow belts or one wide belt is used for conveying sheets. Therefore, one of ordinary skill would have found it obvious to substitute a plurality of parallel belts for what appears to be one wide belt of Wilson et al. to facilitate conveyance of sheets as suggested by Wilson et al. in Fig. 3. Replacing the single belt with a plurality of belts will result in the belts being arranged lengthwise along the dispenser and all belts being driven at the same speed, as set forth in claim 12.


Regarding claim 6, the Wilson et al. patent discloses the claimed invention, except for the different types of media conveyed by the apparatus. It would have been obvious to one having ordinary skill in the art at the time the invention was made to convey any suitable media on the Wilson et al. apparatus, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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